

**REMARKS**

Reconsideration of this application is respectfully requested. Claims 7 – 9 are pending in this application. Claims 7-9 stand rejected.

**Claim Rejections – 35 U.S.C. §103**

Claims 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over **APA** in view of **Willner** (USP 5,790,103). For the reasons set forth in detail below, it is respectfully submitted that the present claims patentably distinguish over the combination of references.

The Examiner relies on the admitted prior art (referred to by the Examiner as **APA**) discussed in the Background of the Invention section of the present application (pages 1-11 and Figs. 1-3) to teach various keys of the keyboard recited in claim 7. The Examiner asserts that **Willner** teaches the keys not taught by the **APA**.

Thus, it is apparent that the Examiner has relied on the known types of 106/109 Japanese keyboard and 101/104 English keyboard shown in Figs. 1 and 2, respectively, of the present application to teach the basic arrangement of the claimed “a key layout corresponding to a 101/104 English keyboard or a 106/109 Japanese keyboard.” The Examiner recognizes that the claimed invention is different from the known types of 106/109 Japanese keyboard and 101/104 English keyboard shown in Figs. 1 and 2, and attempts to supply the elements from the basic 101/104 or 106/109 keyboards by relying on the teachings of **Willner**.

In summary, the Examiner asserts that **APA** teaches the SPACE key and the BACKSPACE key, arranged as recited in claim 7. See Office Action, Item 3, page 2. The

Office Action recognizes that the **APA** does **not** teach the claimed ENTER/RETURN key of the lowermost key array and the claimed DELETE key of the uppermost key array, and relies on **Willner** to allegedly teach these features missing from **APA**. See Office Action, page 3, lines 1-6.

However, as discussed in detail below, it is respectfully submitted that the the Examiner has not established a *prima facie* case of obviousness and the rejection of claims 7-9 under §103 is improper because (1) the combination of references does not disclose or suggest all of the claimed elements, and (2) there is no motivation or incentive to combine the references.

*The rejection under §103 is improper because all the claim limitations are not taught or suggested by the cited prior art.*

As set forth in the Manual of Patent Examining Procedure (MPEP), Eighth Edition, Revision 2, May 2004, §2143.03 “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Office Action asserts that **APA** teaches the SPACE key and the BACKSPACE key, arranged as recited in claim 7. See Office Action, Item 3, page 2. The Office Action recognizes that the **APA** does **not** teach the claimed ENTER/RETURN key of the lowermost key array, and the claimed DELETE key in the uppermost key array, and relies on **Willner** to teach the features missing from **APA**. See Office Action, page 3, lines 1-6.

Firstly, **APA** Figs. 1 and 2 disclose a SPACE key 8 in a lowermost key array 5 positioned in a home position for the left or right thumbs of a user. However, **APA** Figs. 1 and 2 do not disclose or suggest the claimed “middle key array having an extreme right key being a BACKSPACE key.” As shown in Figs. 1 and 2, the BACKSPACE key 12 in these figures is the extreme right key in the *uppermost key array* 4. Therefore, the rejection based on Figs. 1 and 2 of the present application is improper for *at least* the reason that Figs. 1 and 2 do not disclose or suggest the claimed “middle key array having an extreme right key being a BACKSPACE key.”

However, Fig. 3 of the **APA** does illustrate a SPACE key 8 in the lowermost key array 5. However, in the NICOLA keyboard shown in Fig. 3 of the **APA**, the right thumb of a user is not positioned on the SPACE key 8 at a home position for left and right thumbs of a user. Instead, the right thumb of a user is positioned on the next left side key from the SPACE key 8. That is, the SPACE key 8 is positioned at the next right side position from a normal position of the right thumb so that a user must shift or move his or her right thumb to the right in order to depress the SPACE key 8. Fig. 3 also illustrates a BACKSPACE key 12 on the right side of a middle key array.

Thus, even if the Examiner were to rely on Fig. 3 to teach the claimed SPACE key and BACKSPACE key arranged as claimed, these elements are not shown in Fig. 3.

Further, claim 7 clearly recites “A data input keyboard, comprising a key layout corresponding to *a 101/104 English keyboard or a 106/109 Japanese keyboard...*” [emphasis added]. Fig. 3 illustrates a NICOLA keyboard (see, e.g., page 5, lines 13-21 of the present application), and does not illustrate a 101/104 English keyboard or a 106/109 Japanese keyboard.

Therefore, in view of the discussion above, contrary to the Office Action's assertion, the **APA** does not disclose or suggest a data input keyboard comprising a 101/104 English keyboard or a 106/109 Japanese keyboard adapted to include a SPACE KEY and a BACKSPACE key, as recited in claim 7. As noted above, unlike the claimed invention, Figs. 1 and 2 of **APA** do not disclose or suggest the BACKSPACE KEY, as claimed. Further, Fig. 3 of the **APA** does not disclose or suggest a 101/104 English keyboard or a 106/109 Japanese keyboard, as claimed, and does not disclose or suggest the SPACE key, as claimed.

The Office Action relies on **Willner** to teach the "a lowermost key array having a pair of left and right keys centrally juxtaposed in a home position for left and right thumbs of a user, one of the left and right keys being an ENTER/RETURN key and an uppermost key array having an extreme right key being a DELETE key, the ENTER/RETURN key, the SPACE key, the BACKSPACE key, and the DELETE key being a normal state of the keyboard without any key assignment." However, **Willner** does not alleviate any of the deficiencies of **APA** discussed above. Therefore, the combination of references does not teach all the claim limitations.

For all the reasons set forth above, it is submitted that a *prima facie* case of obviousness has not been established. Accordingly, it is submitted that independent claim 7, and claims dependent therefrom, patentably distinguish over the cited prior art for at least the above reasons.

The rejection under §103 is improper because the Office Action has not provided proper motivation for combining **APA** with the **Willner** reference.

For a *prima facie* case of obviousness to exist, there must be “some objective teaching in the prior art or . . . knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

The Office Action asserts “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Willner into APA *for providing the rearranging keyboard*. Also, since it has been held that rearranging parts of the invention involves only routine skill in the art, *In re Japikse*, 86 USPQ 70.” [emphasis added].

Thus, the only motivation or incentive offered in the Office Action for combining the teachings of the references (**APA** and **Willner**) is “for providing the rearranging keyboard.”

However, as noted above, there must be some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead one to rearrange the **APA** keyboard. It is submitted that although the Examiner discusses the teachings of the **Willner** reference, the Examiner has pointed out no teaching in the references or in what is generally known to those skilled in the art that would lead one to rearrange the **APA** keyboard(s) to arrive at the claimed invention. The Examiner has simply concluded that it would be obvious to combine the teachings of the references to provide a rearranged keyboard, without pointing out any evidence in the reference teachings to support this conclusion.

In summary, it is submitted that there is no teaching or suggestion in the **Willner** reference that would lead one of ordinary skill in the art to rearrange the **APA** keyboard to arrive at the presently claimed invention.

Accordingly, in view of the fact that the Office Action has not provided a teaching, motivation or incentive to combine the references it is submitted that a *prima facie* case of obviousness has not been established. The rejection under §103 is improper and should be withdrawn for this additional reason.

Moreover, it is submitted that there is significant disincentive for combining the **Willner** reference with the **APA**. For example, **Willner** teaches that the keyboard *layout* disclosed therein is “*radically* different from that of QWERTY keyboards” (see col. 4. lines 57-58). However, the layout of the **APA** corresponds to the QWERTY keyboard (see, e.g., page 2, lines 1-10 of present application). Further, as described in col. 7, lines 13-50, the **Willner** device has only six character keys (122, 124, 126, 128, 130 and 132) and requires depression of one of four control keys prior to or simultaneously with the appropriate character key to output a desired alphabetic character. This is completely different from the **APA**, wherein depression of one character key outputs a single corresponding character. Thus, it is clear that the **APA** keyboards and the **Willner** keyboard are completely different types of keyboards that operate in completely different manners.

Finally, it is submitted that *In re Japikse* is not applicable to the rejection under §103. More specifically, as set forth in the *Manual of Patent Examining Procedure* (MPEP), §2144.04, *In re Japikse*, 181 F.2d 1019, 86 USP 70 (CCPA 1950), held that claims to a hydraulic press

which read on the prior art except with regard to the position of a starting switch were held unpatentable because shifting the position of the starting switch *would not have modified operation of the device*.

First, it is submitted that the “rearrangement of parts” in the presently claimed invention does indeed modify operation of the prior art device, and is therefore distinguishable from the facts in *In re Japikse*. More specifically, in the present fact situation, the operation of the prior art keyboard is modified and improved by the “rearrangement of parts,” as described, e.g., on page 19, line 25 – page 20, line 3.

Second, it is submitted that *In re Japikse* is not the most relevant case law on the issue of “rearranging parts” under current §103. More specifically, it is submitted that *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984), also cited in the MPEP §2144.04C, is more relevant under current §103. More specifically, in *Ex parte Chicago Rawhide Mfg. Co.* the Board stated “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. *The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes to the reference device*” [emphasis added]. As discussed above, it is submitted that the prior art does not provide a motivation or reason to change the **APA** to arrive at the claimed invention.

Therefore, absent any motivation in the prior art for combining the references to arrive at the claimed invention, it is submitted that the rejection has impermissibly used the applicant’s teachings to hunt through the prior art for the claimed elements and combine them as claimed,

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which amounts to nothing more than hindsight reconstruction of the invention. *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989)

Accordingly, for all the reasons set forth above, it is submitted that a *prima facie* case of obviousness has not been established. Therefore, the rejection under §103 is improper and should be withdrawn.

### **CONCLUSION**

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.



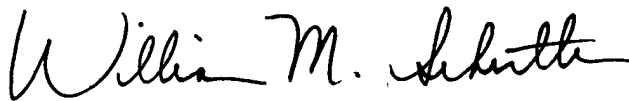
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If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, reading "William M. Schertler". The signature is fluid and cursive, with the first name "William" and last name "Schertler" clearly legible, and "M." in the middle.

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